REMARKS

This is in response to the Office Action of July 8, 2009. Claims 1-10 are pending in this application. Applicants gratefully note that claims 2-10 are not rejected.

Rejection under 35 U.S.C. § 102

Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over US 7,396,865 B2 ("Tsuji"). Office Action, page 3. The Examiner relies upon 35 U.S.C. § 365. However, the Examiner is respectfully requested to consult the attached USPTO training materials on this matter. This rejection is traversed as being patently incorrect on its face.

The Tsuji patent issued on July 8, 2008, which is subsequent to the filing of the present application. Accordingly, the Tsuji patent does not constitute a reference against the present application under 35 U.S.C. §§ 103/102(b) or under 35 U.S.C. §§ 103/102(a). The Tsuji patent has an effective date as a reference under 35 U.S.C. § 102(e) of January 17, 2006, which is the filing date of the continuation application that matured into the Tsuji patent. The Examiner ignored the fact that entry into the U.S. was filed as a by-pass application rather than through the National Phase. The Tsuji reference is not entitled to the date of the filing of the International Application as a reference under 35 U.S.C. § 102(e) since the WIPO publication was not published in the English language.

The Examiner contends that, according to 35 U.S.C. § 365, the Tsuji patent is entitled to the July 22, 2004 filing date of International Application PCT/JP2004/010402. Applicants respectfully disagree as the Examiner's position is not consistent with U.S. law (35 U.S.C. § 102(e)), USPTO policy, and training materials. See the enclosed USPTO training materials.

35 U.S.C. § 365 is irrelevant to the question of effective date as a reference. Looking at 35 U.S.C. § 365 in detail, it is seen that 35 U.S.C. § 365(a) indicates that a national application may claim 35 U.S.C. § 119 foreign priority based upon an International Application which designated a country other than the U.S. 35 U.S.C. § 365(b) indicates that an International Application may claim 35 U.S.C. § 119 foreign priority based upon a prior foreign application.

35 U.S.C. § 365(c) indicates that an International Application may claim 35 U.S.C. § 120 benefit based upon a prior U.S. national application or upon a prior International Application which designated the U.S., and that a national application may claim 35 U.S.C. § 120 benefit based upon a prior International Application which designated the U.S. Thus, 35 U.S.C. § 365 is concerned with foreign and domestic priority dates which U.S. national applications and International Applications designating the U.S. may claim. 35 U.S.C. § 365 says nothing about the effect date of applications as references. Rather, the effective date of a reference is governed by 35 U.S.C. § 102.

The Examiner's attention is respectfully directed to 35 U.S.C. § 363. 35 U.S.C. § 363 provides that "An international application designating the United States shall have the effect ... of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title." (Emphasis added.) 35 U.S.C. § 102(e) provides, in relevant part: "an international application ... shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) ... in the English language." In the present situation, this requirement was not satisfied, so the Tsuji patent only has a 102(e) date when the continuation was filed, because it was filed as a by-pass application.

More specifically, in this case, the Tsuji patent claims benefit to an International Application which was filed on or after November 29, 2000. The WIPO publication of the Tsuji International Application was not in English. (The WIPO publication was WO 2005/010101 A1, which was published in Japanese.) Therefore, the publication of the Tsuji International Application does not constitute a reference under U.S.C. § 102(e). Since the Tsuji patent issued from a U.S. continuing application (not a U.S. National Phase application) claiming benefit of the International Application, the effective date as a reference under 35 U.S.C. § 102(e) of the Tsuji patent[1] is the filing date of the continuing application itself – that is, January 17, 2006.

The present application is the U.S. National Phase of an International Application which

[1] It is noted that if a patent issues from a U.S. National Phase of an International Application which was filed on or after November 29, 2000 and the WIPO publication thereof was not in English, the U.S. National Phase application, when issued as a patent, would have *no* 35 U.S.C. § 102(e) date.

was filed on November 26, 2004. The November 26, 2004 international filing date of the present application is the effective U.S. filing date of the present application – in accordance with 35 U.S.C. § 363. Accordingly, the Tsuji patent – with its effective date as a reference of January 17, 2006 – does not constitute a reference against the present application under 35 U.S.C. § 102(e).

Technological comments

Applicants supply the following comments concerning the technological merits of the rejection.

The Examiner takes the position that a polymer using butadiene (norbornene-butadiene copolymer) prepared by substituting butadiene for ethylene contained in the norbornene-ethylene copolymer disclosed by Tsuji would be equivalent to the cyclized conjugated diene polymer of the present invention. However, the cyclized conjugated diene polymer of the present invention is a compound having in the molecule thereof a cyclic structure derived from conjugated diene monomer units of a conjugated diene polymer. See the third full paragraph on page 6 of the specification. Thus, a norbornene-butadiene copolymer prepared by simply copolymerizing conjugated diene and another monomer containing a cyclic structure cannot be regarded as equivalent to the cyclized conjugated diene polymer of the present invention. Therefore, the Tsuji patent does not render Applicants' invention unpatentable because the technology which it discloses is not in fact suggestive of Applicants' invention.

Objection to claims

On page 3 of the Office Action, objection was raised to claims 2-10 on the ground that they depend from a rejected base claim. Applicants respectfully submit that the rejection of record of independent base claim 1 should be withdrawn, for reasons discussed hereinabove. Withdrawal of the rejection would obviate the objection stated in the Office Action.

Contact information

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: October 8, 2009

Respectfully submitted,

By _____ #43575
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Enclosure: 5 pages

35 USC §102(e) AFTER H.R. 2215[1]

"A person shall be entitled to a patent unless —
* * * * *

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or"(emphasis added)

[1]**Caveat:** The relevant effective date provision of HR 2215 requires that the old (Pre-AIPA) §102(e) applies when the prior art reference is a patent issued (directly or indirectly) from an IA which was filed before 11/29/00.

§ 102(e) Prior Art Date for Publication and Patent based (directly or indirectly) on an IA

The international filing date of an IA is a critical threshold condition in determining the effective prior art date of an application **publication** and **patent**

The critical inquiry is:

Does the IA have an international filing date <u>on or after</u> 11/29/00 (Guidelines 2 and 3),

or

Does the IA have an international filing date <u>prior to</u> 11/29/00 (Guidelines 4 and 5).

Note: For information on obtaining WIPO documents to determine the IA filing date, whether the US was designated and publication language see slides 45-51 in the Appendix.

Applying 35 USC § 102(e): U.S. Patents of IAs (Guideline 3 of 5)

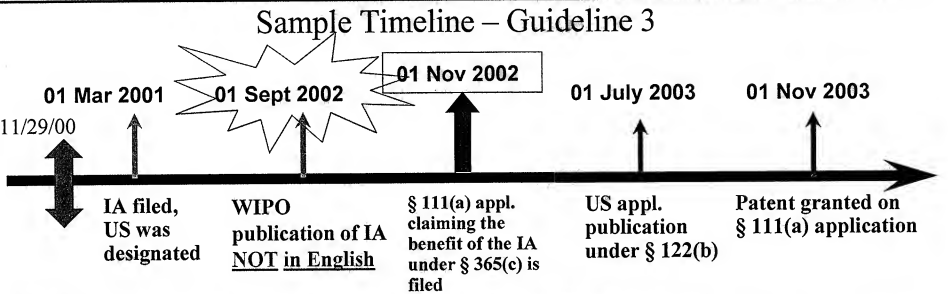
Guideline 3. If the U.S. patent issued from, or claims benefit to, an IA which was filed on or after 11/29/00, but the WIPO publication was not in English, the U.S. patent:

if issued from the 35 USC § 371 application, has **no** § 102(e)(2) date, or

if issued from a U.S. continuing application claiming benefit of the IA, has for its § 102(e)(2) date the filing date of a later-filed continuing U.S. application

See examples P3A and P3B (supra) and P3C (appendix).

Ex. P3A: PATENT DERIVED FROM § 111(a) CONTINUATION OF AN IA FILED ON/AFTER 11/29/00, WIPO PUBLICATION NOT IN ENGLISH



Guideline 3. If the U.S. patent issued from, or claims benefit to, an IA which was filed on or after 11/29/00, but the WIPO publication was not in English, the U.S. patent: if issued from the 35 USC § 371 application, has **no** § 102(e)(2) date, or if issued from a U.S. continuing application claiming benefit of the IA, has for its § 102(e)(2) date the filing date of a later-filed continuing U.S. application

§ 102(e)(2) date of the patent: *01 Nov 2002*

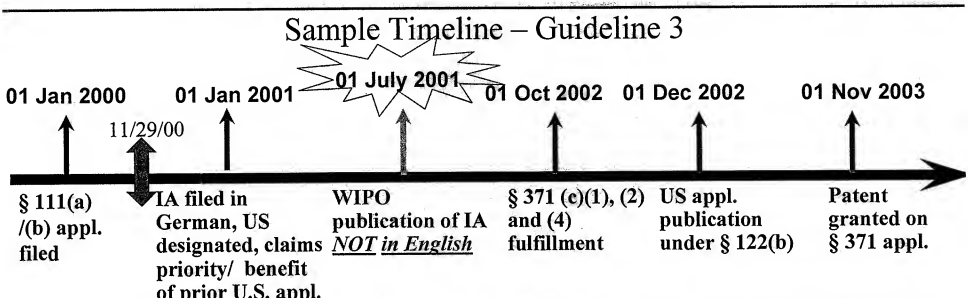
Notes: 1) The WIPO publication does NOT have a § 102(e)(1) date because the IA was not published in English.

2) § 102(e)(1) date of the U.S. appl. publication: *01 Nov 2002.*

3) The best prior art date for the disclosure is the § 102(a) or (b) date (01 Sept 2002) of the IA publication by WIPO.

4) Prior to the AIPA, the § 102(e) date would have been the same 01 Nov 2002.

Ex. P3B: PATENT DERIVED FROM THE NS OF AN IA (§ 371 APPLICATION) WHICH CLAIMS PRIORITY/BENEFIT OF A U.S. APPLICATION (IA FILED ON/AFTER 11/29/00, WIPO PUBLICATION NOT IN ENGLISH)



Guideline 3. If the U.S. patent issued from, or claims benefit to, an IA which was filed on or after 11/29/00, but the WIPO publication was not in English, the U.S. patent: if issued from the 35 USC § 371 application, has no § 102(e)(2) date, or if issued from a U.S. continuing application claiming benefit of the IA, has the § 102(e)(2) date of the filing date of a later-filed continuing U.S. application

§ 102(e)(2) date of the patent: NONE

Notes: 1) U.S. appl. publication and WIPO publication do NOT have a § 102(e)(1) date because the IA was not published in English.

2) The best prior art date for the disclosure is the § 102(a) or (b) date ~~01 July 2001~~ of the IA publication by WIPO.

3) Prior to the AIPA, the § 102(e) date of the patent would have been 01 Oct 2002.